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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,660	02/01/2001	Sagahiro Taho	723-1006	3512

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EXAMINER
WHITE, CARMEN D

ART UNIT	PAPER NUMBER
3714	7

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/774,660	Applicant(s) TAHO ET AL.	
	Examiner Carmen D. White	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 February 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Drawings

The drawings of the application have been approved and stamped by the Draftsperson.

Claim Objections

Claims 3, 4, 5, 17, 18, 21, 32, 33 and 34 are objected to because of the following informalities: the claims recite the language "for second game machine" and "for first game machine". The examiner suggests changing this to --for ***the*** second game machine-- and --for ***the*** first game machine-- for grammatical clarity. Appropriate correction is required.

Claim 11 is objected to because of the following informalities: Claim 11 recites "the emulator program includes" in line 11 of the claim. A colon (:) needs to be placed after "includes" for claim clarity. Appropriate correction is required.

Claims 16-18 are objected to because of the following informalities: Claims 16-18 recite "said game information storage medium includes" and "said first game machine includes" in lines 6 and 13, respectively. A colon (:) needs to be placed after "includes" for claim clarity. Appropriate correction is required.

Claim 20 is objected to because of the following informalities: Claim 20 recites "said game information storage medium includes" and "said first processing system includes" in lines 7 and 15, respectively. A colon (:) needs to be placed after "includes" for claim clarity. Appropriate correction is required.

Claim 24 is objected to because of the following informalities: Claim 24 recites "the emulator program includes" in line 11. A colon (:) needs to be placed after "includes" for claim clarity. Appropriate correction is required.

Claim 28 is objected to because of the following informalities: Claim 28 recites "said game information storage medium includes" in line 6. A colon (:) needs to be placed after "includes" for claim clarity. Appropriate correction is required.

Claim 29 is objected to because of the following informalities: Claim 29 recites "a game information storage medium used for the first game machine includes". A colon (:) needs to be placed after "includes" for claim clarity. Appropriate correction is required.

Claims 11 and 30 are objected to because of the following informalities: the claim numbers are written as follows ".11" and ".30". This appears to be a typographical error. Appropriate correction is required.

Claim 18 is objected to because line 6 of the claim recites "the emulation program". This appears to be a typographical error, since it is referred to as "emulator program" in the prior claims.

Claim 21 is objected to because line 19 of the claim recites "the emulate program". This appears to be a typographical error, since it is referred to as "emulator program" in the prior claims.

Claim 34 is objected to because line 6 of the claim recites "the emulation program". This appears to be a typographical error, since it is referred to as "emulator program" in the prior claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "the provisionally-selected game title" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites, "wherein graphics data of a plurality of kinds of characters usable in a game, further including the steps of:" There appears to be missing information in this claim language that makes it difficult for the examiner to ascertain the scope of the claims.

Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eliott teaches the use of an emulator.

Attachment

The examiner has included an attachment to this office action to notify applicant of the recent changes in 35 USC 102(e).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Miyamoto*** et al (6,132,315).

Regarding claims 1, 3, 6, 8-11,14-16,19-24, 27-30, 32 and 36, Miyamoto teaches a game information storage medium utilized for a first game machine having a first architecture that includes the features of the instant claims as it pertains to, in summary, a storage medium that can be used on a first and second game machine, without the machines having similar architecture and processing speeds (abstract; col. 1, lines 9-15 and lines 25-64; col. 2, lines 44-67; col. 3, lines 11-22; col. 4, lines 56-67; col. 7, lines 5-10; col. 7, lines 65-67 through col. 8, lines 1-3; col. 9, lines 45-47 and lines 63-65; col. 10, lines 54-65; col. 12, lines 4-24). While Miyamoto teaches various menus for player selection, Miyamoto is silent regarding the explicit teaching of the feature of allowing the user to choose a game title. The examiner takes official notice that it is well known in the art to store multiple games on a storage medium and allow the player to choose the game that he/she wishes to play. The game storage medium and graphics system of Miyamoto are functionally capable of achieving this function. It would have been obvious to a person of ordinary skill in the art at the time of the invention to further incorporate this feature in Miyamoto in order to increase the excitement of the game, whereby the player can play a different game depending on his or her current mood.

Regarding claims 2, 4-5, 12, 17-18, 25, 31 and 33-34, Miyamoto teaches all the limitations of the claims as discussed above. Miyamoto is silent regarding the explicit

disclosure of two game programs being stored on the storage medium. Miyamoto is also silent on the feature of two emulator programs. However, the examiner takes official notice that it is well known in the art to store multiple games and programs on a single storage medium. This makes the game system more efficient and versatile. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Miyamoto.

Regarding claims 7, 13, 26 and 35, Miyamoto teaches all the limitations of the claims as discussed above. Miyamoto is silent regarding the explicit teaching of the preliminary information indicative of an outline of a game according to a program. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to enhance the display of Miyamoto to include a preliminary showing of game title and program information to entice players to play games that he/she may not be familiar with, initially. This would increase play of the game and thereby increase game sales for the gaming company.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-308-7768 for Non-official communications and 703-305-3579 for Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

C. White
Patent Examiner

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.